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10/673,085

09/26/2003

Jeffrey P. Rios

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10/24/2006

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EXAMINER

VETTER, DANIEL

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/673,085

**Applicant(s)**

RIOS ET AL.

**Examiner**

Daniel P. Vetter

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8, 13, 15 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 13, 15 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/26/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 09/26/03, 01/25/06
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

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### DETAILED ACTION

Claims 1-6, 8, 13, 15, and 20-24 are currently pending in this application.

#### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 20. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### *Specification*

1. The disclosure is objected to because of the following informalities: a period is missing from the end of paragraph 0016. Appropriate correction is required.

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2. The use of the trademark POSTBACKOFFICE has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Please capitalize the trademark in paragraphs 0019, 0022.

The use of the trademark SMARTMAILER has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Please capitalize the trademark in paragraph 0021.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The disclosure is objected to because of the following informalities: reference number 126 is labeled a franking machine in paragraph 0026. Throughout the remainder of the application reference character 126 is labeled a mailing machine (Fig. 2, ¶ 0030). The specification does not state that these are interchangeable terms. Appropriate correction is required.

#### *Claim Objections*

4. Claims 4-5 are objected to as being substantial duplicates with the same scope. The specification does not sufficiently differentiate the limitation "encoded" recited in claim 4 from the limitation "encrypted" recited in claim 5. For searching purposes,

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Examiner is interpreting "encrypted" as "encoded" (see Webster's II New Riverside University Dictionary, 1994, page 430, Reference U of the attached PTO-892).

5. Claims 22-23 are objected to as being substantial duplicates with the same scope. The specification does not sufficiently differentiate the limitation "encoded" recited in claim 22 from the limitation "encrypted" recited in claim 23. For searching purposes, Examiner is interpreting "encrypted" as "encoded" (see Webster's II New Riverside University Dictionary, 1994, page 430, Reference U of the attached PTO-892).

*Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 8 recites the limitation "a postage amount" in line 3. It is unclear in light of the specification the difference between this limitation and the "postage data" previously recited in the claim. For the purposes of examining, Examiner is interpreting a postage amount as postage data.

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9. Claim 15 recites the limitation "a postage amount" in line 3. It is unclear in light of the specification the difference between this limitation and the "postage data" previously recited in the claim. For the purposes of examining, Examiner is interpreting a postage amount as postage data.

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3-6, 8, 13, 15, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaghi, U.S. Patent No. 6,571,223 (Reference A of the attached PTO-892) in view of Moed, et al., U.S. Patent No. 5,770,841 (Reference B of the attached PTO-892).

12. As per claim 1, Vaghi teaches a method for processing a mailpiece comprising: receiving a mailpiece that includes representative data on a region of the mailpiece (column 5, lines 2-6); the representative data being in machine-readable format (column 5, lines 6-7); calculating postage data as a function of the representative data (column 5, lines 13-14); printing an indicia on the mailpiece that represents the postage data

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(column 5, lines 18-21); generating a control signal as a function of the representative data (column 6, lines 28-33); and modifying operation of a mailing machine as a function of the control signal (column 6, lines 32-33). Vaghi does not teach obtaining image data of the mailpiece; and does not teach transmitting at least a portion of the image data to a storage location for subsequent use in tracking the mailpiece. Moed, et al., teaches obtaining image data of the mailpiece (column 3, lines 56-57); and transmitting at least a portion of the image data to a storage location for subsequent use in tracking the mailpiece (column 9, lines 8-9, 24-26). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate obtaining image data of the mailpiece and transmitting at least a portion of the image data to a storage location for subsequent use in tracking the mailpiece into the method taught by Vaghi. One having ordinary skill in the art would have been motivated to incorporate obtaining image data of the mailpiece and transmitting at least a portion of the image data to a storage location for subsequent use in tracking the mailpiece to form a unified package record, which may be used to facilitate the track and sorting of the package throughout the delivery system (as taught by Moed, et al., column 9, lines 61-63).

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13. As per claim 3, Vaghi in view of Moed, et al. teaches the method of claim 1 as described above. Vaghi further teaches the representative data includes a barcode (column 2, line 47).

14. As per claim 4, Vaghi in view of Moed, et al. teaches the method of claim 1 as described above. Vaghi further teaches the representative data is encoded (column 2, line 46).

15. As per claim 5, Vaghi in view of Moed, et al. teaches the method of claim 1 as described above. Vaghi further teaches the representative data is encrypted (column 2, line 49).

16. As per claim 6, Vaghi in view of Moed, et al. teaches the method of claim 1 as described above. Vaghi does not explicitly teach that the representative data uniquely identifies the mailpiece. Moed, et al. teaches the representative data uniquely identifies the mailpiece (column 2, line 38). Examiner is interpreting a package identification number as uniquely identifying the mailpiece. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the representative data uniquely identifies the mailpiece into the method taught by Vaghi. One having ordinary skill in the art would have been motivated to incorporate the representative data uniquely identifies the mailpiece to form a unified package record



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which may be used to sort and track the package (as taught by Moed, et al., column 2, lines 45-48).

17. As per claim 8, Vaghi in view of Moed, et al. teaches the method of claim 1 as described above. Vaghi further teaches calculating postage data further comprises: adding a surcharge to a postage amount for the mailpiece to account for additional services specified for the mailpiece in the representative data (column 5, lines 49-52; column 6, lines 43-46). Examiner is interpreting computing a postal rate based on other parameters such as overnight delivery as adding a surcharge to a postage amount for the mailpiece to account for additional services specified for the mailpiece in the representative data.

18. As per claim 13, Vaghi teaches an apparatus comprising: means for receiving a mailpiece that has representative data on a region of the mailpiece (column 5, lines 2-6); the representative data being in machine-readable format (column 5, lines 6-7); means for calculating postage data as a function of the representative data (column 5, lines 13-14); means for printing an indicia on the mailpiece that represents the postage data (column 5, lines 18-21); means for generating a control signal as a function of the representative data (column 6, lines 28-33); and means for modifying operation of a mailing machine as a function of the control signal (column 6, lines 32-33). Vaghi does not teach means for obtaining image data of the mailpiece; and does not teach means

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for transmitting at least a portion of the image data to a storage location for subsequent use in tracking the mailpiece. Moed, et al., teaches a means for obtaining image data of the mailpiece (column 3, lines 56-57); and a means for transmitting at least a portion of the image data to a storage location for subsequent use in tracking the mailpiece (column 9, lines 8-9, 24-26). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate means for obtaining image data of the mailpiece and means for transmitting at least a portion of the image data to a storage location for subsequent use in tracking the mailpiece into the apparatus taught by Vaghi. One having ordinary skill in the art would have been motivated to incorporate means for obtaining image data of the mailpiece and means for transmitting at least a portion of the image data to a storage location for subsequent use in tracking the mailpiece to form a unified package record, which may be used to facilitate the track and sorting of the package throughout the delivery system (as taught by Moed, et al., column 9, lines 61-63).

19. As per claim 15, Vaghi in view of Moed, et al. teaches the apparatus of claim 13 as described above. Vaghi further teaches the means for calculating postage data further comprises: means for adding a surcharge to a postage amount for the mailpiece to account for additional services specified for the mailpiece in the representative data (column 5, lines 49-52; column 6, lines 43-46). Examiner is interpreting computing a

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postal rate based on other parameters such as overnight delivery as adding a surcharge to a postage amount for the mailpiece to account for additional services specified for the mailpiece in the representative data.

20. As per claim 21, Vaghi in view of Moed, et al. teaches the apparatus of claim 13 as described above. Vaghi further teaches the representative data includes a barcode (column 2, line 47).

21. As per claim 22, Vaghi in view of Moed, et al. teaches the apparatus of claim 13 as described above. Vaghi further teaches the representative data is encoded (column 2, line 46).

22. As per claim 23, Vaghi in view of Moed, et al. teaches the apparatus of claim 13 as described above. Vaghi further teaches the representative data is encrypted (column 2, line 49).

23. As per claim 24, Vaghi in view of Moed, et al. teaches the apparatus of claim 13 as described above. Vaghi does not explicitly teach that the representative data uniquely identifies the mailpiece. Moed, et al. teaches the representative data uniquely identifies the mailpiece (column 2, line 38). Examiner is interpreting a package identification number as uniquely identifying the mailpiece. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the representative data uniquely identifies the mailpiece into the apparatus taught by

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Vaghi. One having ordinary skill in the art would have been motivated to incorporate the representative data uniquely identifies the mailpiece to form a unified package record which may be used to sort and track the package (as taught by Moed, et al., column 2, lines 45-48).

24. Claims 2 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaghi in view of Moed, et al., in further view of Minckler, U.S. Patent No. 6,612,676 (Reference C of the attached PTO-892).

25. As per claim 2, Vaghi in view of Moed, et al. teaches the method of claim 1 as described above. Vaghi in view of Moed, et al. does not teach modifying operation of a mailing machine includes temporarily pausing operation of the mailing machine.

Minckler teaches modifying operation of a mailing machine includes temporarily pausing operation of the mailing machine (column 8, lines 16-19). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate modifying operation of a mailing machine includes temporarily pausing operation of the mailing machine into the method taught by Vaghi in view of Moed, et al. One having ordinary skill in the art would have been motivated to incorporate modifying operation of a mailing machine includes temporarily pausing operation of the mailing machine to wait for a response to a detected print fault (as taught by Minckler, column 8, lines 17-19).

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26. As per claim 20, Vaghi in view of Moed, et al. teaches the apparatus of claim 13 as described above. Vaghi in view of Moed, et al. does not teach the means for modifying includes means for temporarily pausing operation of the mailing machine. Minckler teaches means for modifying includes means for temporarily pausing operation of the mailing machine (column 8, lines 16-19). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate means for modifying includes means for temporarily pausing operation of the mailing machine into the apparatus taught by Vaghi in view of Moed, et al. One having ordinary skill in the art would have been motivated to incorporate means for modifying includes means for temporarily pausing operation of the mailing machine to wait for a response to a detected print fault (as taught by Minckler, column 8, lines 17-19).

*Information Disclosure Statement*

27. The information disclosure statement filed January 23, 2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein (References AL and AM) has not been considered.

*Conclusion*

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Uno, et al., U.S. Patent No. 5,535,127 (Reference D of the attached PTO-892) teaches an automatic mail processing apparatus comprising a physical quantity detection section for detecting physical quantities of mail with a stamp, such as the weight and dimensions of the mail, a postage determining section for determining the valid postage for the mail, and a processing section to identify the kind of the mail, classify the mail, and compile statistics data on the mail. Gil, et al., U.S. Patent No. 5,586,037 (Reference E of the attached PTO-892) teaches an automated self-service mail processing and storing system with a tracking bar code generation means and a tracking bar code verification system. Petkovsek, U.S. Patent No. 6,400,829 (Reference F of the attached PTO-892) teaches a system for automatically imaging special service forms and affixing same to an envelope with a mailpiece handler for accepting mailpieces having a machine readable code and also teaches a method of fully automating imaging of special service forms and affixing same to an envelope comprising the steps of inserting a mailpiece having a code into a mailpiece handler, reading the code from the mailpiece, storing addressee and/or sender data, processing the code from the mailpiece to select a corresponding stored addressee and/or sender data, imaging the corresponding addressee and/or sender data onto a

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form, and assembling the form with the mailpiece.. Sansone, U.S. Patent No. 5,978,781 (Reference G of the attached PTO-892) teaches digital printing, metering, and recording of other post services on the face of a mail piece for reducing the use of gummed service stickers and the completion by hand of special forms for specialty mail.


29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571) 272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**PATRICK J. NOLAN, PH.D.**  
**SUPERVISORY PATENT EXAMINER**  
10/19/02

  
Daniel P. Vetter  
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